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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,360	11/29/2001	Rowan Bosworth-Davies	TN223	5529

7590 07/17/2006

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3693

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,360

Applicant(s)

BOSWORTH-DAVIES ET AL.

Examiner

JAGDISH PATEL

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7, 9, 16-19 and 22-67 is/are rejected.
- 7) ☒ Claim(s) 2, 6, 8, 10-15, 20 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is in response to amendment filed 4/19/06.

Response to Amendment

2. Claims 1, 14, 22, 35, 43, 44, 57, and 65 have been amended and new claims 66 and 67 have been added.

Response to Arguments

3. Applicant's arguments with respect to prior claim rejection have been considered but are moot in view of the new ground(s) of rejections.
4. This office action is made non-final due to rejection of previously allowed claims over a newly found prior art.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 22-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 22-42 and 44-64 recite limitation “detecting a potential for the presence of financial irregularity..to produce an outcome”. It is unclear how this limitation functionally

relate to any other process step of the claim, which renders the claim unclear. One cannot determine how applying “said predetermined set of predetermined rules” relates to “detecting a potential for .. the financial irregularities” as recited in the claim.

Furthermore, the recitation “to produce an outcome indicative of the potential..” is only stated as intended result of the detecting process. Thus, the claim as a whole fails to produce the intended outcome as stated in the preamble. It is suggested that this process step be written positively as:

“producing an outcome indicative of the potential for a financial irregularities.. by detecting a potential for the presence of financial irregularity based upon the result of the applying step.”

Dependent claims 23-42 and 45-64 also inherit same deficiencies.

6. Claims 43, 65-67 recite limitation “weighting the outcome” which is vague and unclear because no specific terms or basis of the weighting are specified. Referring to claim 7, the outcome of running each rule is weighted (according to importance of each rule). Claims 43 and 65 should clearly specify the manner in which the weighting is applied to the outcome.

Claims 43 and 65 are also rendered indefinite because it recites “producing a user-readable output of rules transgression if any transgression exceeds a predetermined threshold”. Since the transgression is (a discrete event of) violation of a rule, how is it quantified to be compared against a threshold?

The claims also recite limitations of “providing a user operable device” which have no relation to other limitations because the claim does not refer to these parameters elsewhere.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, rejected under 35 U.S.C. 102(e) as being clearly anticipated by Lee et al. (US 2002/0099649) (hereafter referred to as Lee).

As per claim 1 Lee teaches a system for identifying a potential for financial irregularities in a financial transaction (see abstract), which system comprises a first database for storing at least one transaction and for containing information related to at least one client and at least one account of said at least one client upon which said at least one transaction can be effected;

(see Figure 1 block 1 106, "out-sorted orders 106 are stored in a file system (and may be sequenced for handling" [0076])

a processor loaded with a rules engine. including a predetermined set of predetermined rules said predetermined rules being selectable from a set of rules available for selection by an institution responsible for said first database, said predetermined set of predetermined rules to apply to said at least one transaction for determining a potential for the presence of financial irregularity in said at least one

transaction, the processor being operable to access the data in the database to run the predetermined set of rules in respect of the data and to produce an outcome indicative of the potential for a financial irregularity being present in the at least one transaction.

(see Figure 1, block 112 and [0068] "The rule engine 112 implements various rules 108 that establish its policies for dealing with fraudulent or potentially fraudulent transactions."

See ([0075] The merchant defines rules 108 ... The PMW allows the merchant to define, edit, delete any rules it desires.)

Claims 3-5: set of rules includes a first (a second, a third) group of rules ..

(see [0217] five different rule basis 403 used by the rule engine]

Claim 6: the processor is operable to combine the outcomes of running at least a selection of the rules in the set to produce an overall outcome indicative of the potential for a financial irregularity.

(see [0075] note that the fraud score is generated from the merchant selected rules)

Claim 9: user input means for disabling at least one input means. (see claim 1 analysis)

claims 10 and 11: the processor includes a routine for applying a threshold value to each outcome, which routine is arranged to generate an output of transgression of the rule if the threshold is crossed.

..applying a threshold value to the overall outcome..

([0343] A primary output of the eFalcon system 100 is the fraud score that measures the likelihood that each order is fraudulent. In one embodiment, the merchant may create a rule that sets a threshold, or "cutoff score," above which all orders are rejected. The merchant might then create a different rule, with a lower threshold score, "outsort score," for which all orders receiving scores above that threshold and less than the first are flagged for further investigation.).

Claim 16-18: limitations are explicitly disclosed in the cited prior art (see Fig. 1).

Claim 19. the outcome is translated into a user alert indicative of the potential for the presence of a financial irregularity in the transaction (see Fig. 4, message 405).

Allowable Subject Matter

9. Claims 2, 6, 8, 10-15, 20-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Claims 22-67 are allowable subject correction of deficiencies identified under 35 USC 112 (second).

Conclusion

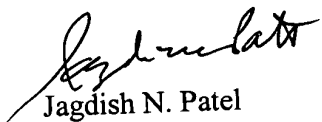
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

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Art Unit: 3693

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

7/10/06